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From: Scott.Elmer@stjude.org
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To: scpcomments@uspto.gov
Subject: Comments on the International Effort to Harmonize the Substantive Requirements of Patent Laws

Mr. Jon Santamauro:

My comments regarding the harmonization issues outlined in Fed. Reg. 66(53):15409-15411 (March 19, 2001) are provided below.

Issue 1: I believe the first to file system is better for two basic reasons; ease of application and ultimate fairness. First of all, determining who is the first to file a sufficient disclosure of the same invention is far easier than determining which party was the first to commit the metaphysical act of "invention". The only questions that have to be answered under the first to file system are (1) When was the application filed?; and (2) Was the application a sufficient disclosure of the invention? All patent offices have reliable methods for establishing filing dates for applications, so answering the first question is easy. The second question is a bit more difficult but can be answered through application of legal requirements for the adequate disclosure of an invention.

In contrast, applying the first to invent system requires these same two questions to be answered, plus a Pandora's Box of additional questions and issues. The act of invention is a mental feat for which direct evidence does not exist. Therefore one must look for indirect evidence of invention, such as written records or witness recollections typically from parties who have some bias in favor of one inventor or the other. It is no surprise that such evidence is far from perfect and conclusive in most cases. Therefore you are left with a judgement call based on whatever evidence there may be. Once this issue has been addressed for all parties, depending on the circumstances you may also have to determine whether sufficient diligence was undertaken by the first party to invent until they reduced the invention to practice. Additional issues regarding inequitable conduct, bar dates, etc. may also arise during this complex quasi-trial procedure conducted by the Patent Office.

The only justification I am aware of for going through this expensive, time consuming (we are talking years!) and laborious interference process is the idea that awarding patent rights to the first party to invent is fairer than awarding such rights to the party who won the race to the patent office and filed first. While this idea has merit when considered in the abstract, it loses all merit when one takes into account the practical realities of implementing this system. As noted above, the act of invention is a mental process that, in almost all cases, cannot be determined with any degree of certainty. As a result, the outcome of an interference tends to depend more on the skill level and persuasiveness of the opposing attorneys (and perhaps the access of the inventors to good legal advice at the time of invention and thereafter) than on the scant and inadequate evidence available for making the necessary judgements.

The U.S. should face the reality that awarding patent right to the first inventor, while a laudable goal, is an ideal that cannot be achieved in the real world because in most cases it is impossible to know with certainty who was really the first to invent. In my opinion we should stop wasting our time, money and effort trying to attain the unattainable and join the rest

of the world by adopting the first to file system. Because this system does not require an attorney to understand it, I believe it actually places individual inventors and on a more level playing field with larger corporations and is therefore fairer in practice than the first to invent system.

Issue 2: In my view, whether certain subject matter should be absolutely precluded from patenting is a political issue that should be left to the legislatures of the various countries. I do not see that there is a need for all countries to reach agreement on this issue and I foresee great difficulty in completely harmonizing this aspect of the patent laws.

Issue 3: The application disclosure requirements under the U.S. system seem to me to result in better and more complete disclosures of an invention than the requirements of other countries. Therefore I would advocate for the U.S. to maintain its requirements and urge the rest of the world to adopt these requirements as part of the harmonization process.

Issue 4: This "technical field" requirement sounds like an indirect way to limit patentable subject matter and should not be adopted.

Issue 5: The real issue here is money. The U.S. and other countries use restriction practice and unity of invention practice as a way of breaking all applications down into a common denominator so that the price charged for examining an application roughly corresponds to the amount of time needed to examine it. Thus if an application is large and complex with a lot of claims it will require a lot of time to examine and is typically deemed to contain several inventions. The only practical difference between the two systems is that the U.S. requires applicants to go through the process of filing divisional applications to pursue all their claims while other countries allow you to have all your claims examined at once as long as you pay for it.

My suggestion here would be for everyone to adopt the system which appears to be the most predictive when it comes to reflecting examination time; i.e. the system that best separates claims into groups that require roughly equivalent examination times. Whichever system is used, applicants should be allowed to have all of their claims examined in the same application as long as they pay for it. The requirement of filing divisional applications to pursue separate claim groups should be abolished.

Issue 6: I am not convinced that any utility requirement is necessary. I see no reason to deny an applicant the right to patent their invention because it is deemed to have no "utility" or "industrial applicability". If the invention truly has no utility, it will not prevent others from doing anything useful so what is the harm in granting a patent on such an invention. The time, money and effort it takes to prepare and file a patent application appears to me to be a sufficient deterrent to those who might otherwise file truly frivolous applications.

Considering my view on the questionable value of the utility requirement, it should come as no surprise that I favor the more permissive U.S. standard compared to the industrial applicability of other countries.

Issues 7 and 8: These areas beg for a set of simple rules to eliminate the undue complexity that has been created by U.S. and foreign laws regarding the prior art effect of patent applications.

Issue 9: Experienced patent applicants, or those who have access to good legal advice, do not utilize the U.S. "grace period" because doing so means that you have forfeited ex-U.S. rights. If we go to a first to file system, I believe it necessarily follows that we should lose our current "grace

period". Otherwise we will inevitably create some cottage industry of parties who race to the patent office with applications based on the public disclosures of others.

Issue 10: I see no reason to keep our current geographical limitations with respect to prior art. We are in a global economy and inventions should be new and nonobvious based on what is known globally. While this standard requires us to assume the fiction that one of ordinary skill in the art is aware of all relevant global prior art when considering obviousness and anticipation issues, this is not much different than the current assumption that the skilled artisan is aware of all relevant prior art in a designated geographical area (even including knowledge of patent disclosures before they have been published).

Issue 11: Regarding public use and on-sale/offer for sale bars, these loss of rights provisions appear to me to often be used as legal "gotchas" to invalidate otherwise valid patents based on activities innocently undertaken by individuals before they have considered patenting their inventions. The caselaw appears to have muddled the application of these standards and caused me to question their value.

If we go to a first to file system, I don't think these loss of rights provisions are necessary. The specter of losing the race to the patent office should sufficiently deter those who might otherwise attempt to extend their effective patent term by undertaking the pre-filing activities that the loss of rights provisions are currently intended to discourage.

Issue 12: This appears to me to be another example of U.S. courts unduly muddying the waters in an attempt to reach the right result. If the use of multiple references to establish anticipation were truly only applied in limited circumstances then I would agree with U.S. practice. However, I am not convinced this is the case. See, e.g. *Ciba-Geigy Corp. v. Alza Corp.*, 33 USPQ2d 1018 (DC NJ 1994), affirmed, 37 USPQ2d 1337 (Fed. Cir. Unpub. 1995) (Judge Rader dissenting).

Issue 13: Whatever standard is used to determine obviousness is bound to be fraught with problems inherent in making a determination that requires one to avoid the temptation of hindsight and disavow current knowledge. As a U.S. practitioner, I naturally prefer the standard that has evolved here. However, I am not nearly as familiar with the "inventive step" and other standards that foreign countries have used and thus am not a good one to assess the relative merits of these various standards.

Issue 14: No comment.

Issues 15 and 16: I think that you have to consider claim interpretation and the doctrine of equivalents together because both issues relate to the balance all patent systems try to achieve between competing goals of adequately rewarding the inventor and providing effective notice of the metes and bounds of an inventor's patent rights to competitors. While some countries may not use the doctrine of equivalents or a similar doctrine, they may not need to because they interpret patent claims in a manner designed to reach an equitable result.

I do not think the right balance can be achieved with clear, black and white rules. The rules have to be flexible to allow decision makers to reach an equitable result in any particular instance. In this instance I think the actual rules or doctrines themselves are less important than the manner in which they are applied. Therefore here I would suggest that the countries attempt to agree on where to strike the appropriate balance between the interests of the inventors and the interests of their competitors and the public and then consider which rules best allow this balance to be achieved.

Issue 17: No comment.

Other issues: I was surprised that the duty of disclosing prior art required by the U.S. Patent Office was not raised as a harmonization issue. I have mixed feelings regarding this requirement, but generally feel that it improves the patent examination process and makes it more efficient.

Disclaimer: The opinions above are personal to me and do not reflect the opinions of my employer.

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